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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL WILLIAM GRADY, LAURA SINCLAIR,
PAUL HOUSTON, and PETER JOHN DOYLE

Appeal 2008-2749
Application 09/254,407
Technology Center 1600

Decided: August 22, 2008

Before DONALD E. ADAMS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-10, 14 and 15. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a wound dressing. Claim 1 is representative of the claims on appeal, and reads as follows:

1. A wound dressing or ointment comprising a synthetic sulfated polysaccharide selected from the group consisting of sulfated cellulose derivatives and sulfated polyanionine polysaccharides, said synthetic sulfated polysaccharide being present in an amount sufficient to bind matrix metalloproteinases.

We affirm.¹

ISSUE (Indefiniteness)

The Examiner contends that claims 6 and 7 are indefinite under 35 U.S.C. § 112, second paragraph, because the term “saccharine residue” lacks antecedent basis and that it appears that Appellants meant to refer to a “saccharide residue.” (Ans. 3.)

Appellants do not argue the merits of the issue, merely stating that they “believe their amendments under 37 CFR 1.116 have addressed the Examiner’s concerns.” (App. Br. 6.) We note, however, that the

¹ Claims 11-13 are also pending, but stand objected to under 37 C.F.R. § 1.75(c) as being in improper form, as a multiple dependent claim cannot depend from another multiple dependent claim (Ans. 3). Appellants ask us to review the objection (App. Br. 8-9). However, claim objections are not appealable. *See* MPEP § 706.01 (“rejection” appealable to Board; “objection” of the type applied to claim 15 reviewed by way of petition to PTO Director). Thus, “the Board will not hear or decide issues pertaining to objections and formal matters.” (*Id.*)

amendment after final did not amend the term “saccharine residue” in rejected claims 6 and 7.

Therefore, as Appellants have not addressed the merits of the rejection, it is summarily affirmed.

ISSUE (Obviousness)

The Examiner contends 1-10, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tunc (U.S. Patent No. 3,939,836, issued February 24, 1976).

Appellants contend that Tunc does not render obvious a wound dressing or ointment that binds matrix metalloproteinases (MMPs) (App. Br. 7).

Thus, the issue on Appeal is: Does Tunc render teach or suggest a wound dressing comprising a synthetic sulfated polysaccharide?

FINDINGS OF FACT

FF1 Claims 1-10, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tunc.²

² We note that while the Examiner had rejected claims 1-10 and 13 under 35 U.S.C. § 103(a) as being obvious over the combination of Easton and Tunc in the Final Rejection (mailed February 14, 2003) (Final Rejection 3), the rejection on appeal does not appear in the Final Rejection, and thus appears to be a new ground of rejection. At the time of filing of the Appeal Brief (dated March 18, 2004), under 37 C.F.R. § 1.193(a)(2), the Examiner was prohibited from entering a new ground of rejection in the Examiner’s Answer. MPEP § 1208.01 (Eighth Edition, Rev. 1, (Feb. 2003)). However, “[a]ny allegation that an examiner’s answer contains a impermissible new

FF2 Tunc is cited for teaching “a water dispersible nonwoven fabric comprising 4 percent to about 35 percent by weight of a binder comprising an alkali salt of a sulfated cellulose ester.” (Ans. 4.)

FF3 The Examiner finds that the examples of Tunc do not teach the use of an alkali salt of a sulfated cellulose ester, but that the abstract does disclose their use in a surgical dressing (Ans. 4).

FF4 Specifically, Tunc teaches that “[n]onwoven fabrics are widely used as components of such disposable goods as sanitary napkins, diapers, wound dressings, bandages, nursing pads and the like.” (Tunc col. 1, ll. 11-13.)

FF5 Tunc teaches further:

The improved nonwoven fabric of this invention comprises one or more layers of overlapping, intersecting fibers and from about 4 percent to about 35 percent by weight of the fabric of binder. The binder comprises an alkali salt of a sulfated cellulose ester resin, such as, for example, sodium, potassium, or lithium cellulose acetate sulfate; sodium, potassium or lithium cellulose acetate-butyrate sulfate; potassium cellulose butyrate sulfate; and sodium cellulose propionate sulfate. Most preferably the resin binder used in the present invention comprises sodium cellulose acetate sulfate. If so desired, the binder may comprise mixtures of the various alkali cellulose ester sulfates.

ground of rejection is waived if not timely.” (*Id.*) In response to the Examiner’s Answer, Appellants filed an Amendment After Appeal (dated November 10, 2004), stating that the amendment place “the claims in better form for consideration by the Board by addressing Examiner’s and specific objections and rejections as clarified in the Examiner’s Answer.” As Appellants thus did not object to the new grounds of rejection in the Examiner’s Answer, we deem that they waived any objection, and thus decide the merits of the rejection.

(Tunc col. 1, ll 54-66.)

PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

ANALYSIS

Appellants argue that from Tunc “it is not apparent why the claimed wound dressings or ointments which bind MMP’s would be obvious,” as Tunc “is not concerned with treatment of chronic wounds and binding of MMP’s.” (App. Br. 7.) Specifically, Appellants argue that they “have demonstrated that the sulfated polysaccharides of the present invention are

superior in binding MMP which have been implicated in preventing the healing of chronic wounds.” (*Id.*)

Appellants’ arguments are not convincing, as Appellants are merely arguing an inherent property of the alkali salt of a sulfated cellulose ester, which Tunc specifically teaches as a type of compound which may be incorporated into a wound dressing. “Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.” *MEHL/Biophile Intern. Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

CONCLUSIONS OF LAW

We thus conclude that Tunc renders obvious the dressing of claim 1. As Appellants do not separately argue claims 2-10, 14, and 15 separately, we affirm the rejection as to those claims as well. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. 37 C.F.R. § 41.37(c)(1)(vii).

TIME LIMITS

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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cdc

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